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EXAMINER

NGUYEN, TOAN D

|          |              |
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| ART UNIT | PAPER NUMBER |
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2665

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/679,689

Applicant(s)

RIEMANN ET AL.

Examiner

Toan D. Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 33-36 are objected to because of the following informalities:

For claim 33 line 1, it is suggested to change "computer data network" to ---  
computer data computer network ---.

For claim 33 line 9 and line 25, it is suggested to change "said computer network"  
to --- said computer data computer network ---.

For claim 33 line 12, it is suggested to change "the computer data network" to ---  
the computer data computer network ---.

For claim 34 line 8, it is suggested to change "said computer data network" to ---  
said computer data computer network ---.

For claim 34 line 9 and line 19, it is suggested to change "said computer network"  
to --- said computer data computer network ---.

For claim 34 line 12, it is suggested to change "the computer data network" to ---  
the computer data computer network ---.

For claim 35 line 4, line 9 and line 14, it is suggested to change "said computer  
network" to --- said computer data network ---.

For claim 36 line 16 and line 17, it is suggested to change "said network" to ---  
said computer data network ---.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. Claims 36-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 recites the limitation "said server" in line 13. There is insufficient antecedent basis for this limitation in the claim.

3. Applicant is advised that should claim 24 be found allowable, claim 31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Double Patenting***

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 23-32 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 10-20 of prior U.S. Patent No. 5,892,764. This is a double patenting rejection.

Art Unit: 2665

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 33-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24 and 54 of U.S. Patent No. 5,892,764. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claims 33-35 merely broaden the scope of the claims 24 and 54 of U.S. Patent No. 5,892,764 by eliminating converts voice, modem and tone transmission, a second interface adapter that translates voice signals at said handset to an asynchronous data stream for transmission over said computer data network, and detect dialing of a "9" or an equivalent code by any one of said plurality of handsets.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

<sup>33-35</sup>  
5. Claims<sub>33-35</sub> are rejected under 35 U.S.C. 103(a) as being unpatentable over Baratz et al. (US 5,742,596) as applied to the claims above, and further in view of Murai (US 6,208,639).

For claim 33, Baratz et al. disclose network based distributed PBX system comprising:

a plurality of telephone means (figure 1, references 41 and 42, col. 4 lines 36-38);

an external interface means (figure 1, reference 43) for coupling said computer data computer network (figure 1, reference 37) to at least one outside trunk line of a public switched telephone network (PSTN) (figure 1, reference 12), wherein said

external interface means translates telephony transmissions from the PSTN (figure 1, reference 12), to data for transmission over said computer data network (figure 1, reference 37) (col. 4 lines 10-15 and col. 6 lines 7-15);

software means for said computer network, said software means comprising first means for performing the functions of a private branch exchange (PBX) (figure 2, reference 10) for said plurality of telephone means (figure 2, reference 22) that are connected to the computer data network (figure 2, reference 37) (col. 6 line 65 to col. 7 line 5 and col. 7 lines 35-39);

said software means comprising second means for receiving requests for service over said computer data computer network for any of said plurality of telephones means (col. 5 lines 63-66);

said software means comprising third means for establishing communications over said computer data computer network between any two of said telephone means upon receiving a request over said computer data computer network for calling one of said plurality of telephone means from another of said plurality of telephone means (col. 5 line 63 to col. 6 line 6, and col. 6 lines 55-57); and

said software means comprising fourth means for establishing communications over said computer data computer network between any one of said plurality of telephone means and said interface to said PSTN upon receiving a request over said computer network for an outside line for said one of said plurality of telephone means col. 6 lines 7-15, and col. 6 lines 55-57).

However, Baratz et al. do not expressly disclose bi-directional media streams over said computer data computer network. In an analogous art, Murai discloses establishing bi-directional media streams over said computer data computer network (col. 9 lines 24-25). One skilled in the art would have applied Murai's bi-directional transmission in Baratz et al.'s operation of system 10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Murai's computer network system with telephone function in Baratz et al.'s network based distributed PBX system with the motivation being transmitted packet data on the computer network (col. 6 lines 3-4).

For claim 34, Baratz et al. disclose network based distributed PBX system comprising:

- a plurality of telephone means (figure 1, references 41 and 42, col. 4 lines 36-38);

- an external interface means (figure 1, reference 43) for coupling said computer data computer network (figure 1, reference 37) to at least one outside trunk line of a public switched telephone network (PSTN) (figure 1, reference 12), wherein said external interface means translates telephony transmissions from the PSTN (figure 1, reference 12), to data for transmission over said computer data network (figure 1, reference 37) (col. 4 lines 10-15 and col. 6 lines 7-15);

- software means for said computer network (figure 2, reference 37), said software means comprising first means for performing the functions of a private branch exchange (PBX) (figure 2, reference 10) for said plurality of telephone means (figure 2, reference



22) that are connected to the computer data network (figure 2, reference 37) (col. 6 line 65 to col. 7 line 5 and col. 7 lines 35-39);

said software means comprising second means for receiving requests for service over said computer data computer network (figure 2, reference 37) for any of said plurality of telephones means (col. 5 lines 63-66);

said software means comprising third means for establishing communications over said computer data computer network (figure 2, reference 37) between any one of said plurality of telephone means (figure 1, references 41) and said interface to said PSTN upon receiving a request over said computer network for an outside line for said one of said plurality of telephone means (col. 5 lines 63-65, and col. 6 lines 7-15).

However, Baratz et al. do not expressly disclose bi-directional media streams over said computer data computer network. In an analogous art, Murai discloses establishing bi-directional media streams over said computer data computer network (col. 9 lines 24-25). One skilled in the art would have applied Murai's bi-directional transmission in Baratz et al.'s operation-of system 10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Murai's computer network system with telephone function in Baratz et al.'s network based distributed PBX system with the motivation being transmitted packet data on the computer network (col. 6 lines 3-4).

For claim 35, Baratz et al. disclose network based distributed PBX system comprising:

a plurality of telephone means (figure 1, references 41 and 42, col. 4 lines 36-38);

software means for said computer network (figure 2, reference 37), said software means comprising first means for performing the functions of a private branch exchange (PBX) (figure 2, reference 10) for said plurality of telephone means (figure 2, reference 22) that are connected to the computer data network (figure 2, reference 37) (col. 6 line 65 to col. 7 line 5 and col. 7 lines 35-39);

said software means comprising second means for receiving requests for service over said computer data computer network (figure 2, reference 37) for any of said plurality of telephones means (col. 5 lines 63-66);

said software means comprising third means for establishing communications over said computer data computer network (figure 2, reference 37) between any two of said telephone means (figure 1, references 41) upon receiving a request over said computer data computer network for calling one of said plurality of telephone means from another of said plurality of telephone means (col. 5 line 63 to col. 6 line 6, and col. 6 lines 55-57).

However, Baratz et al. do not expressly disclose bi-directional media streams over said computer data computer network. In an analogous art, Murai discloses establishing bi-directional media streams over said computer data computer network (col. 9 lines 24-25). One skilled in the art would have applied Murai's bi-directional transmission in Baratz et al.'s operation of system 10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Murai's

Art Unit: 2665

computer network system with telephone function in Baratz et al.'s network based distributed PBX system with the motivation being transmitted packet data on the computer network (col. 6 lines 3-4).

6. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baratz et al. (US 5,742,596) as applied to the claims above, and further in view of Catchpole (US 5,822,306).

As far as understood with respect to claim 36, Baratz et al. disclose network based distributed PBX system comprising:

a software means performing the functions of a private branch exchange (figure 2, reference 10) running on at least one computer (figure 1, reference 40) operatively coupled to said computer data network (figure 1, reference 37) (col. 4 line 7 and col. 4 lines 36-37);

a PSTN interface means for coupling the computer data network (figure 1, reference 37) to a public switched telephone network (figure 1, reference 12)(col. 4 lines 10-15);

a plurality of telephone means (figure 1, references 41 and 42, col. 4 lines 36-38);

telephone interface means (figure 1, reference 43) for coupling said plurality of telephone means (figure 1, reference 41) to said computer data network (figure 1, reference 37), said telephone interface means (figure 1, reference 43) converting analog signals into digital data for transmission over said computer data network (col. 5 line 66 to col. 6 line 1);

said server (figure 1, reference 44) comprising computer means, and memory means (col. 6 lines 16-17); and

software means stored in said memory means (col. 6 lines 16-17) for controlling the signaling between said plurality of telephone means (figure 1, reference 41) and said network (figure 1, reference 37) , whereby said network (figure 1, reference 37) acts as a switch for connecting any of said telephone means to a called party (col. 6 lines 48-57).

However, Baratz et al. do not expressly disclose said network acts as a switch for connecting audio signals from any of said telephone means. In an analogous art, Catchpole discloses network acts as a switch for connecting audio signals from any of said telephone means (col. 1 line 20).

One skilled in the art would have recognized the network acts as a switch for connecting audio signals from any of said telephone means, and would have applied Catchpole's PBX 4 in Baratz et al.'s operation of system 10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Catchpole's multimedia in Baratz et al.'s network based distributed PBX system with the motivation being to provide a switching arrangement in a call center environment (col. 1 lines 14-15).

For claim 37, Baratz et al. disclose wherein said computer network is one of a: asynchronous transfer mode (ATM), Ethernet, or Internet Protocol (IP) network (col. 4 line 21).

7. Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baratz et al. (US 5,742,596) as applied to the claims above, and further in view of Andersen et al. (US 5,674,003).

For claim 38, Baratz et al. disclose network based distributed PBX system comprising:

(a) coupling a plurality of telephones (figure 1, references 41 and 42) to the computer data network (figure 1, reference 37) for digital data transmission over the computer data network (col. 4 lines 10-39);

(b) using the computer data network as a PBX (figure 1, reference 10) for switching between the plurality of telephones (figure 1, reference 41) for making call from one telephone to another of the plurality of telephones, or between at least one of the telephones and the public switched telephone network (PSTN) (col. 5 line 63 to col. 6 line 15 and col. 6 lines 48-57).

However, Baratz et al. do not expressly disclose:

(c) said step (b) comprising assigning priority to the audio signals from the plurality of telephones. In an analogous art, Andersen et al. disclose assigning priority to the audio signals from the plurality of telephones (col. 15 lines 57-58).

One skilled in the art would have recognized the assigning priority to the audio signals from the plurality of telephones, and would have applied Andersen et al.'s telephony connection in Baratz et al.'s operation of system 10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Andersen et al.'s mechanisms for accessing unique features of telephony networks from

a protocol-independent data transport interface in Baratz et al.'s network based distributed PBX system with the motivation being to establish the telephony connection (col. 15 line 48).

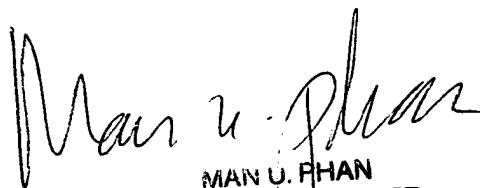
For claim 39, Baratz et al. disclose wherein said step (a) comprises connecting the plurality of telephones to one of a: asynchronous transfer mode (ATM) network, Ethernet network, or Internet Protocol (IP) network (col. 4 line 21).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D. Nguyen whose telephone number is 571-272-3153. The examiner can normally be reached on M-F (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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